

REMARKS

The present remarks and amendments are responsive to the Office Action mailed on June 14, 2004. Claims 1-52 are pending in this application. Claims 1-25, 27-28, 31, 34, and 42-52 have been provisionally cancelled without prejudice. In addition, claims 26, 29-30 and 32-33 have been amended and claims 53-55 have been added as new claims. No new matter has been presented. Support for the amendments can be found, inter alia, in Applicant's original specification and original claims.

Also accompanying this communication is a petition to extend the prosecution on this matter for three months and the appropriate fee. By the following remarks, remaining pending claims 26, 29-30, 32-33 and 35, and new claims 53-55 are believed to be in condition for allowance along with allowed claims 36-41 and are presented for reconsideration and examination.

Discussion of the Office Action

In the Office Action of June 14, 2004, the Examiner rejected claims 1 and 21 under 35 U.S.C. §102 (b) as anticipated by Durant et al (US Patent No. 6,016,212 B1), he rejected claims 1-3 and 21-22 under 35 U.S.C. §102 (b) as anticipated by Morioka et al (US Patent No. 5,539,562), and he rejected claims 26, 28, 34-35, 42, and 49-50 under 35 U.S.C. §102 (b) as anticipated by Sharp et al (US Patent No. 5,317,442). In addition, the Examiner rejected claims 4 and 23 under 35 U.S.C. §103 (a) as being unpatentable over Morioka (US Patent No. 5,539,562) as applied to claim 1 and in view of Aprahamian (US Patent No. 5,886,9,800), he rejected claims 5 and 15-18 under 35 U.S.C. §103 (a) as being unpatentable over Morioka (US Patent No. 5,539,562) in view of Aprahamian (US Patent No. 5,886,9,800), and in further view of Sharp (US Patent No. 5,317,442), he rejected claims 6-14, 24, and 25 under 35 U.S.C. §103 (a) as being unpatentable over Morioka (US Patent No. 5,539,562) in view of Aprahamian (US Patent No. 5,886,9,800), in further view of Sharp (US Patent No. 5,317,442) as applied to claim 5, and in further view of Davis et al (US Pat. No. 5,166,507), he rejected claims 27 and 43 as being unpatentable over Sharp (US Patent No. 5,317,442), as applied to claims 26 and 42, respectively, and in view of Davis (US Pat. No. 5,166,507), he rejected claims 29-33 under 35 U.S.C. §103 (a) as being unpatentable over Sharp (US Patent No. 5,317,442), as applied to claims 29- and in further view of Morioka (US Pat. No. 5,539,562), he rejected claims 44-47, 51, and 52, under 35 U.S.C. §103 (a) as being unpatentable over Sharp (US Patent No. 5,317,442), as applied to claim 43, and in further view of Morioka (US Pat. No. 5,539,562), he rejected claim 48 under 35 U.S.C. §103 (a) as being unpatentable over Sharp (US Patent

No. 5,317,442), as applied to claim 42, in view of Davis (US Pat. No. 5,166,507), and in further view of Morioka (US Pat. No. 5,539,562); and finally, he objected to claims 19 and 20 as being dependent upon a rejected base claim.

Rejection of claims 1-3, 21-22, 26-28, 34-35, 42, and 49-50 under 35 U.S.C. § 102(b)

The Examiner rejected claims 1-3, 21-22, 26-28, 34-35, 42, and 49-50 under 35 U.S.C. § 102(b).

Claims 1-3, 21-22, 27-28, 34, 42 and 49-50 have been provisionally cancelled. In light of the cancellation of such claims, the issue is rendered moot.

Claims 26 and 35 however, have been rejected under 35 U.S.C. § 102(b) as anticipated by Sharp et al. (US Patent No. 5,317,442).

Regarding **claim 26**, Applicant has amended independent claim 26 as follows:

A method of communicating that uses a laser beam comprising:
intercepting a receiving means with a conjugate beacon beam;
forming a hologram by interfering the conjugate beacon beam with a local oscillator beam, wherein the formed hologram comprises a grating pattern having a fringe orientation and period that are a function of a magnified angle of incidence of the conjugate beacon beam;
intercepting the receiving means with a communications beam comprising a configured phase pattern of the conjugate beacon beam;
deflecting the communications beam to a fixed course relative to the local oscillator beam as a result of the processed grating pattern; and

detecting the deflected communications beam.

Applicants respectfully submit that Sharp et al (U.S. Pat. No. 5,317,442) **does not disclose or suggest** anywhere the underlined limitations as shown above in amended claim 26. Therefore, Sharp et al. does not teach every element of Applicants' claim 26.

Under §MPEP 2129, "[t]o anticipate a claim, the reference must teach every element of the claim."

Accordingly, in light of the amendments, this ground of rejection under 35 U.S.C. §102(b) of **claim 26** and dependent **claim 35**, which depends from claim 26 and therefore contains all the limitations of claim 26, is believed improper and should be withdrawn.

Rejection of claims 4--18, 23-25, 27, 29-33, 43-47, and 51-52 under 35 U.S.C. §103(a)

The Examiner rejected claims 4 -18, 23-25, 27, 29-33, 43-47, and 51-52 under 35 U.S.C. §103(a).

Claims 4 -18, 23-25, 27, 31, and 43-47 have been provisionally cancelled. In light of the cancellation of such claims, the issue is rendered moot.

Claims 29-30, and 32-33 however, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sharp et al. (US Patent No. 5,317,442) as applied in the claims 26 and 28, and in further view of Morioka (U.S. Pat. No. 5,539,562). Applicants must traverse such a rejection.

Under MPEP §2142, as one of the three prongs to establish a *prima facie* case of obviousness “The prior art reference (or references when combined) must teach or suggest all the claim limitations.”

As set forth in the rejection of claim 26 under 35 U.S.C. § 102(b), Sharp et al does not teach or suggest all of the limitations of amended claim 26. Applicants respectfully further submit that Morioka in combination with Sharp et al also do not teach or suggest all the limitations of claims 26 to warrant an obvious rejection under 35 U.S.C. §103(a). Moreover, claims 29-30, and 32-33, have been amended to directly depend from claim 26, and thus contain all the limitations of claim 26.

Under MPEP §2143.01, “If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.” In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Accordingly, Applicant respectfully submits that the rejection of claims 29-30, and 32-33 under 35 U.S.C. §103(a) is improper and is requested to be removed.

Objection of claims to claims 19 and 20

Claims 19 and 20 have been provisionally cancelled as set forth above. Thus, the issue is rendered moot.

Discussion of New Claims 53-55

Applicant has submitted new claims 53-55 in order to more clearly claim the conditions of the present invention.

ALLOWABLE SUBJECT MATTER

Claims ~~36-41~~ have been allowed by the Examiner.

CONCLUSION

The undersigned respectfully submits that, in view of Applicant's amendments, the rejections of the claims raised in the Office Action dated June 14, 2004 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that remaining pending claims 26, 29-30, 32-33, and 35, and new claims 53-55 be allowed in addition to allowed claims 36-41, and that this case be passed to issue. In the event that the Examiner finds any remaining impediment to the prompt allowance of these claims that can be clarified with a telephone conference, she is respectfully requested to initiate the same with the undersigned at (925) 422-3682.

Respectfully submitted,

Dated: _____

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